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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,531	12/14/2001	Sukhendu B. Dev	GENE1180-2	1163
35938	7590	06/10/2004	EXAMINER	
BIOTECHNOLOGY LAW GROUP 658 MARSOLAN AVENUE SOLANA BEACH, CA 92075			LAM, ANN Y	
			ART UNIT	PAPER NUMBER

1641

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/020,531

Applicant(s)

DEV ET AL.

Examiner

Ann Y. Lam

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-4, 7-13, 16, 17-20, 23-24 and 29, 30-, 34.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800/641

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments are not persuasive. Applicants argue that the '700 patent is not an electroporation apparatus, but is an iontophoresis device. Applicants argue that electroporation to the extent that it is disclosed in the '700 patent, is directed to releasing components from cells by breaking those cells down, rather than introducing components into cells, as is claimed by Applicants. In response, Examiner points to column 7, lines 42-44 in which patent '700 states that the "invention can also be used to effect drug release by electroporation, which is the electrical breakdown of cells which contain substances such as hemolytic compounds, genes and the like." Examiner asserts that a device having an electric field of a strength required for the electrical breakdown of cells to release substances is capable of providing for the introduction of substances into a cell by creating an opening in the cell membrane, as is well known in the art. Examiner emphasizes that Applicants are claiming a device, as opposed to a method, and thus if the prior art structure is capable of performing the intended use, then it meets the claims.

Applicants also assert on page 7, second paragraph, that small changes in electrode distance can have large effects on electric field strength and cell viability. Examiner points out that nothing in the '700 patent requires that the electrical breakdown cause permanent damage to or a permanent breakdown of cells. Electroporation is a well known art in which cells undergoing electroporation remain viable.